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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,999	08/20/2001	Frank-Rainer Bohm	FA-1022	8379

7590 10/30/2002  
E I du Pont de Nemours & Company  
Legal Patents  
Wilmington, DE 19898

EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/30/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/913,999

Applicant(s)

BOHM ET AL.

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,15-18,25 and 26 is/are rejected.
- 7) ☒ Claim(s) 14,19-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 13, 15-18, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Majumdar et al.
3. Majumdar discloses a photographic element comprising an antistatic coating layer on a substrate, where the antistatic layer comprises a colloidal silica, a polymeric binder, and an electrically conductive element (abstract). Since the photographic element contains an electrically conductive element, it is the examiner's position that the photographic element is an electrical conductor. The preferred colloidal silica is Ludox AM, a silica modified to contain hydroxyl groups. The silica is a silica-oxygen network in the form of 5-25 nm-particles (col. 5 lines 36-43). The reference teaches a wide range for weight ratios of silica to binder, where additives can also be included (col. 6 lines 32-53). From the discussion in the reference, one of ordinary skill in the art would clearly envision the applicant's claimed weight ratios of the components. Furthermore, from

the discussion of surface modification of the silica particles, it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%".

4. Claims 15-16 limit  $R_3$  and  $R_4$ , respectively, without limiting the reactive particles to contain additional radicals  $R_3$  and  $R_4$ . Since the silica particles of the reference do not seem to have additional functionality,  $R_3$  and  $R_4$  would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

5. Claims 13, 15-18, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Vassiliou as evidenced by Majumdar et al.

6. Vassiliou discloses a coating composition comprising a colloidal silica, a fluorocarbon polymer, and a number of additives (col. 1 lines 59-63). The reference prefers the use of Ludox AM (col. 2 lines 30-47), noted by Majumdar as a silica modified to contain hydroxyl groups (col. 5 lines 36-43). Preferred particle sizes range from 7 to 25 millimicrons. Composition A shows ~31 wt.% colloidal silica, ~46 wt.% of polymer binder dispersion, and ~23 wt.% of additives or solvents. From the discussion of surface modification of Ludox AM silica particles in Majumdar et al., it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%". The coatings of

Vassiliou's invention are intended for metal substrates, thus providing coating compositions for electrically conductive substrates.

7. Claims 15-16 limit  $R_3$  and  $R_4$ , respectively, without limiting the reactive particles to contain additional radicals  $R_3$  and  $R_4$ . Since the silica particles of the reference do not seem to have additional functionality,  $R_3$  and  $R_4$  would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

#### ***Allowable Subject Matter***

8. Claims 14 and 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

10. The closest prior art, Vassiliou, discloses a coating composition comprising a colloidal silica, a fluorocarbon polymer, and a number of additives. The coatings are air-dried and baked; however, the reference does not mention the curing of the fluorocarbon composition at an elevated temperature, nor does the reference mention the use of crosslinking agents. Furthermore, the reference does not suggest the applicant's  $R_1$  radicals of claim 14 or the reactive particles of claim 19. It is the examiner's position that the applicant's claimed process including thermal curing steps

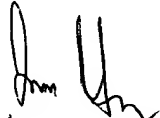
would be novel and unobvious over the prior art. It is also the examiner's position that the applicant's claimed coating compositions having specific reactive particle according to claims 14 or 19 would be novel and unobvious over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb  
October 28, 2002

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700